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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 26

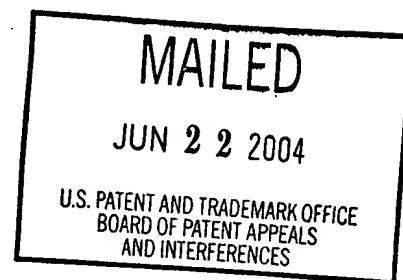
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGORY P. ANDREWS and KEVIN P. GIBSON

Appeal No. 2003-0451
Application No. 08/818,158

ON BRIEF



Before JERRY SMITH, FLEMING and NAPPI, Administrative Patent Judges.

NAPPI, Administrative Patent Judge.

Decision on Appeal

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 38 through 75.

The Invention

The invention relates to a web browser to view web pages on the internet. The web browser is used to download and view web pages, typically formatted using Hypertext Markup Language (HTML), see appellants' specification page 2. The web

pages frequently refer to files of images, graphics or other programs, referred to as "components", which are displayed with the web page, see appellants' specification paragraph bridging pages 2 and 3. These "components" are downloaded separately from the HTML document, see appellants' specification page 3. Since downloading of the components can be time consuming, appellants' web browser provides the user of the computer with a list of components to be downloaded and allows the user to determine which components to download, see appellants' specification page 4.

Claim 50 is representative of the appellants' invention.

50. A method for downloading a document, the document including a document with references to a plurality of components, the method comprising the steps of:

- a) downloading said document
- b) prompting a user to select which of said plurality of components to download;
and
- c) downloading said selected components.

References

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| Martino | 6,044,382 | Mar. 28, 2000 (filed Jun. 20, 1997) |
| Heath et al. (Heath) | 6,006,034 | Dec. 21, 1999 (filed Sep. 5, 1996) |

Rejections at Issue

Claims 38 through 75 stand rejected under 35 U.S.C. § 103 as being unpatentable over Heath et al. in view of Martino

Opinion

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief¹ along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejections and the arguments of appellants and examiner, for the reasons stated *infra*, we will reverse the rejection of claims 38 through 75 under 35 U.S.C. §103.

Analysis

Appellants argue, on page 5 of the brief, that the combination of the references do not teach the claimed limitation of "prompting a user to select which of said plurality of components to download." Appellants argue on page 5 of the brief, that Heath et al. "has no option as to which components will be downloaded." On page 6 of the brief, appellants point out that Martino teaches a computer system that makes use of forms and that the forms are not analogous to appellants' claimed "components". On page 7 of the brief, appellants argue "like Heath et al., Martino does not disclose or suggest the claimed feature of 'dynamically prompting a user to select which of a plurality of

¹This decision is based upon the Appeal Brief received February 27, 2002 (certified as being mailed on February 19, 2002 in accordance with 37 C.F.R. §1.8(a)) .

components to download” and as such the combined teachings do not disclose the claimed concept.

Before we consider the teachings of the references used in the rejection under 35 U.S.C. § 103, we must first determine the scope of the claims. Claims will be given their broadest reasonable interpretation consistent with the specification, limitations appearing in the specification will not be read into the claims. *In re Etter* 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985). In analyzing the scope of the claim, office personnel must rely on the appellant's disclosure to properly determine the meaning of the terms used in the claims. *Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321 (1996). “[I]nterpreting what is *meant* by a word in a claim ‘is not to be confused with adding an extraneous limitation appearing in the specification, which is improper.’” (emphasis original) *In re Cruciferous Sprout Litigation*, 301 F.3d 1343, 1348, 64 USPQ2d 1202, 1205, (Fed. Cir 2002) (citing *Intervet America Inc v. Kee-Vet Laboratories Inc.* 12 USPQ2d 1474, 1476 (Fed. Cir. 1989)). “[T]he terms used in the claims bear a “heavy presumption” that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art.” *Tex Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002). “Moreover, the intrinsic record also must be examined in every case to determine whether the presumption of ordinary and customary meaning is rebutted.” (citation omitted). “Indeed, the intrinsic record may show that the

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specification uses the words in a manner clearly inconsistent with the ordinary meaning reflected, for example, in a dictionary definition. In such a case, the inconsistent dictionary definition must be rejected.” ***Texas Digital Systems, Inc. v. Telegenix, Inc.***, 308 F.3d at 1204, 64 USPQ2d at 1819 (Fed. Cir. 2002).

Claim 50 contains the limitation “prompting a user to select which of said plurality of components to download.” There are two key terms in this limitation, “user” and “components”. The appellants’ specification does not define the term “user.” However, the plain meaning of this term, “a person who uses a device”, is consistent with the usage in the appellants’ specification. See for example page 4 of the appellants’ specification which states “[t]he preferred embodiment uses a download selection mechanism to display a download selection list to a web browser user.” The term “component” is defined in the appellants’ specification. Page 2 of appellants’ specification states:

Many web pages use extensive graphics and other “components” to dress up their web page, where components are defined in this patent to be any additional items references in HTML documents. These components are included in an HTML document through the use of specialized tags. For example ...

Thus, we find that the scope of claim 50 includes that the method step of prompting the person downloading the document to select which items referenced in the HTML document are to be downloaded.

We also find that the scope of the other independent claims 38, 61 and 73 through 75, also include prompting the person downloading the document to select which items referenced in the HTML document are to be downloaded. Claims 38, 61 and 75 each contain the limitation, "said computer program dynamically prompting a user to select which of said plurality of components to download." Claim 73 contains the limitation "said component download selection mechanism prompting a user to select which of said plurality of components to download." Claim 74 contains the limitation "prompting a user to select which of said plurality of embedded components to download by displaying a component download selection list on said web browser."

Having determined the scope of the claims we next consider the rejection based upon 35 U.S.C. § 103. In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. *See also Piasecki*, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and arguments." *Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." *In re Lee*, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). In addition, our reviewing court stated in *In re Lee*, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002), that when making an obviousness rejection based on combination, "there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by Applicant" (quoting *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)).

On page 3 of the brief, the examiner identifies that claims 38-75 are rejected under 35 U.S.C. § 103 as being unpatentable over Heath in view of Martino. The Examiner states "Heath discloses ... a computer program residing in a the memory, said computer program commencing to down load a file referencing a plurality of components." On page 4 of the brief, the examiner states that Heath et al does not teach dynamically prompting the user and relies on Martino to teach this feature. The examiner states: "Martino discloses the executive menu will be automatically presented to the user for selection of the desired menu form or process."

We do not find that the combination of the references teach prompting the user to select which of a plurality of components to download. Martino teaches a system in which transaction entry devices are used to input data. The data entered at the transaction entry device is then distributed to an external database, see column 3, lines 41-45. Forms are used to enter the data and different forms are used for each specific transaction. The purpose of using the forms is that it allows that operating system of the transaction entry device to be independent from the devices which require the data, see column 7, lines 15-30. We find that though the forms may be downloaded from another server, as described in column 17, lines 46-50, the forms do not prompt the user to download components, they prompt the user to enter data. Accordingly, we find that Martino does not provide suggestion to use a menu or form to prompt the user of the device to select components (items referenced in an HTML document) to download.

Summarily, we do not find a suggestion in Heath that the user should be prompted to select components to download. We find that Heath teaches a system to permit upgrading components of a program on a client's computer, see the abstract of Heath. Heath teaches that the components are stored on a server along with a catalog of the components and their version no. see column 1, lines 56-60. To update the program, the client's computer contacts the server and downloads the catalog from the server. The client's computer then compares the version identifiers for the components on the client computer with the version identifiers in the catalog. The program is then updated

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by downloading the components for which the version identifies do not match, see column 1, line 63 to column 2 line 5. Heath teaches in column 6 lines 5-19, that the user can select the program to update, but does not teach that the user is prompted to select the components to be downloaded as part of the update. Heath teaches that the components to be downloaded are selected automatically. The advantage of this system is that it provides a simple mechanism for the user to update a computer from a remote server by "automatically selecting to download and update only the needed and changed components of an application program, the present method alleviates the concerns of time", see column 1, lines 50-51. Thus, we find that modifying Heath to prompt the user to select the components to be downloaded, would frustrate the purpose of Heath as it could lead to an incomplete update of the program.

Accordingly, we will not sustain the examiner's rejection of claims 38 through 75 under 35 U.S.C. § 103 as being unpatentable over Heath and Martino.

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In view of the forgoing, we reverse the rejection of claims 38 through 75 under 35 U.S.C. § 103.

REVERSED

Gerry Smith
JERRY SMITH
Administrative Patent Judge


MICHAEL R. FLEMING
Administrative Patent Judge


ROBERT NAPPI
Administrative Patent Judge

BOARD OF PATENT APPEALS AND INTERFERENCES

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